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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,253	06/09/1998	TAKESADA SHIMURA	146.1286	2129

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ART UNIT	PAPER NUMBER
1653	90

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/068,253	SHIMURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Abdel A. Mohamed	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 February 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2-5,8-11,14 and 15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 2-5, 8-11,14 and 15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

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### **DETAILED ACTION**

#### **ACKNOWLEDGMENT OF AMENDMENT, REMARKS, STATUS OF THE CLAIMS AND SPECIFICATION**

1. The amendment and remarks filed 2/26/03 are acknowledged, entered and considered. In view of Applicant's request the specification and claims 2-3, 8-9 and 14 have been amended. Thus, claims 2-5, 8-11 and 14-15 are now pending in the application. The objections to the abstract and Trademarks and the rejection under 35 U.S.C. 112, second paragraph have been withdrawn in view of Applicant's amendment and remarks filed 2/26/03.

The following objections and rejection are necessitated by Applicant's amendment to the specification and claims.

#### **OBJECTIONS AND REJECTIONS APPLICABLE TO THE CLAIMS**

##### **NEW MATTER OBJECTIONS AND REJECTIONS**

2. The amendment filed 2/26/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of new matter on pages 3-7 and 12-13 by broadening the scope of the invention, change of the language and rearrangement of the specification. There are no support in the originally filed disclosure for "polyoxyethylene-polyoxypropylene" as currently amended. Rather, the originally filed disclosure has support "for

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a composition which contains a polyoxyethylene-polyoxypropylene **glycol**..... ". Also, on page 7, changing "polypropylene glycol" to --polyoxypropylene--. Deletion of "**glycol**" would broaden the classes of polyoxyethylene-polyoxypropylene or polypropylene. Applicant has not pointed out any basis in the originally filed disclosure to support these amendments. The originally filed disclosure is narrower in scope because they disclose explicitly specific classes of polyoxyethylene-polyoxypropylene or propylene having **glycol**.

#### **CLAIMS REJECTION-35 U.S.C. 112, 1<sup>st</sup> PARAGRAPH**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-5, 8-9 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 14 and dependent claims 2-3 and 8-9 as amended on 2/26/03 contain new matter because the original specification does not appear to support the composition comprising ".....polyoxyethylene-polyoxypropylene...." or "....polyoxypropylene...." (Claims 2, 8 and 14) as currently amended because there is no disclosure in the specification or claims for deletion of **glycol** as now claimed. Rather, the originally filed disclosure and claims have

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support "for a composition which contains a polyoxyethylene-polyoxypropylene glycol.....", or "polyoxypropylene glycol". Thus, Applicant respectfully requested to either cancel all unsupported subject matter or to show where such subject matter has support from the original disclosure.

#### **CLAIMS REJECTION-35 U.S.C. 112, <sup>2nd</sup> PARAGRAPH**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5, 8-11 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 14 as written is not properly formulated; the word "wherein" should be inserted before the word "the" on line 4. Appropriate correction is required.

Applicant has indicated on the response filed 2/26/03 that claim 15 was amended in the amendment of 9/11/01 (Paper No. 30) to be dependent upon claim 14. However, on the Advisory Action of Paper No. 31 mailed 10/5/01, the Examiner has clearly explained why the amendment filed 9/11/01 was not entered by stating (See Paper No. 31 Note) The amendments are not submitted properly as they are marked in pencil - not in permanent ink. Additionally, the pencil markings are/is not legible. Thus, claim 15 was not amended as argued by Applicant,

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claim 15 still depends on canceled claim 13; and claims depending on claim 15 thereof directly or indirectly (e.g., claims 8-11) are indefinite in depending directly or indirectly upon canceled claim 13. Therefore, appropriate correction is suggested.

**ACTION IS FINAL, NECESSITATED BY AMENDMENT 5.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**CONCLUSION AND FUTURE CORRESPONDENCE**

6. No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner ca also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196

*AM* Mohamed/AAM

April 17, 2003

*Christopher S.F. Low*  
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